REMARKS

This paper is responsive to the Final Office Action dated December 20, 2006 (the "Final Office Action").

Claims 25-46 were previously pending in the application. Claims 25 and 36 have been amended in this paper. No claims have been canceled or added in this paper. Accordingly, claims 25-46 remain pending.

Claims 25-46 stand rejected.

The amendments add no new matter. Support for the amendments may be found, for example, in the original Specification at p. 22, lines 1-15.

Rejection of Claims under 35 U.S.C. § 103

Claims 25-29, 31-40, and 42-46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,922,791 issued to Mashayekhi et al. ("Mashayekhi") in view of U.S. Patent No. 5,958,070 issued to Stiffler ("Stiffler"). Claims 30 and 41 stand rejected under § 103(a) as being unpatentable over Mashayekhi and Stiffler in view of U.S. Patent Publication No. 2004/0049579 by Imes ("Imes"). Applicant respectfully submits that the claims are allowable in view of the following remarks.

Claim 25 includes a limitation of using a respective priority for each of the applications for identifying a resource to free. The Final Office Action asserts that the cited portions of the references disclose that this limitation is performed "when the set of systems is empty." Applicant respectfully disagrees with this conclusion. Nonetheless, to further prosecution, Applicant has amended claim 25.

Application No. 10/609,363

As amended, claim 25 includes:

when no systems among the plurality of systems meet the requirements for hosting the
> first application,
>> using a respective priority for each of the applications for identifying a resource to
>>> free, wherein
>> the resource is one of a plurality of resources, and
>> each resource is associated with at least one of the plurality of systems.

The cited portions of Mashayekhi and Stiffler, whether taken alone or in combination, fail to disclose each of these limitations.

Mashayekhi states, in relevant part:

It is then determined whether the weight is sufficiently low to indicate that the node has sufficient available resources to satisfy the resources needed by the failed node (step 604b), as was determined at step 601a. If so, then that node is assigned as the failover node (step 605b). If not, then next node is examined, and so on until a suitable failover node is found.

(Mashayekhi at 8:28-34.)

Stiffler states, in relevant part:

After a failure of one of the computers, the surviving computer 1) may run applications of both computers (itself and the failed computer) with a decrease in throughput for any one application, or 2) may terminate its own applications and only run those of the failed computer, or 3) may run a subset of the combined applications that are of sufficiently high priority.

(Stiffler at 10:16-22.)

While the cited portion of Mashayekhi describes examining nodes until a suitable failover node is found, it provides no teaching or suggestion regarding the situation where none of the nodes are suitable. Thus, Mashayekhi fails to teach Applicant's condition, "when no systems among the plurality of systems meets the requirements for hosting the first application." As for the use of application priority in identifying a resource, Stiffler is similarly lacking. The cited portion of Stiffler merely states that after a failure condition, a subset of the combined applications that are of sufficiently high priority may be executed. Although Stiffler suggests choosing applications to run based on their priority, there is no teaching or suggestion to use a priority "for identifying a resource to free." Accordingly, the cited portions of the references fail to disclose using a respective priority for each of the applications for identifying a resource to free, when no systems among the plurality of systems meets the requirements for hosting the first application, as required by Applicant's claim 25.

In addition, Applicant respectfully submits that the Final Office Action fails to establish a *prima facie* case of obviousness under § 103(a). The Final Office Action proposes on p. 3, in para. 8, that:

> it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Mashayekhi and Stiffler because Stiffler teachings to use priorities of applications to free resources to run applications would ensure that high priority applications of a failed node may operate on another node when a suitable failover node cannot be found.

Applicant respectfully disagrees with this characterization of the cited references. The cited portions of the references do not disclose any procedures to be followed "when a suitable failover node cannot be found." Even if this characterization of the references were correct, it

would not offer a motivation or suggestion for the combination of Mashayekhi and Stiffler. Rather, it describes a supposed advantage of Stiffler.

The Final Office Action continues on pp. 3-4 to state:

Cited section (i) of Mashayekhi teaches of continually examining nodes for nodes with sufficient resources. It is reasonably possible that a node may not be found with sufficient resources since there can't be an infinite number of nodes or a number too great due to the cost of implementation.

In this discussion, the Final Office Action appears to set forth a shortcoming of a cited portion of Mashayekhi. This portion (8:28-34) describes examining nodes "until a suitable failover node is found." The cited portions do not, however, describe what happens if a suitable value is *not* found. The cited portions of Mashayekhi do not themselves point out this shortcoming; the cited portions of Mashayekhi do not describe what action should be taken in the event that this shortcoming is encountered. Mashayekhi does not suggest a need for a solution to this issue, and does not even appear to recognize this shortcoming.

Having proposed that Mashayekhi has a shortcoming, the Final Office Action then goes on to propose a solution to that shortcoming. The Final Office Action turns to Stiffler and suggests on p. 4 that:

Cited section (ii) of Stiffler teaches of providing resources to run high priority applications of a failed node.

The sections (i) and (ii) mentioned in this analysis are the very same sections of the references that the Final Office Action puts forth as supposedly teaching limitations of Applicant's claim 25.

Application No. 10/609,363

In this analysis, the Final Office Action has not provided any reasoning that would support the combination of Mashayekhi and Stiffler. At best, the Final Office Action has found a shortcoming of one of the references—a shortcoming that is not recognized or discussed in either of the cited references. The Final Office Action then proposes, using reasoning not found in the references, that a solution to the supposed shortcoming in cited section (i) can be found by combining it with cited section (ii)—thereby making the very combination that the Final Office Action previously suggested would achieve Applicant's invention.

At best, the Final Office Action has used hindsight with the benefit of Applicant's disclosure to discern a shortcoming in the cited references, and to address that shortcoming. The shortcoming appears in the Final Office Action only as part of a discussion that leads to a combination of teachings that supposedly adds up to Applicant's invention. Having noted a problem that is not noted in the cited portions of the references, the Final Office Action then goes on to propose a solution to this problem by effectively suggesting that the reason to combine Mashayekhi and Stiffler would be to achieve Applicant's invention (by combining the cited sections (i) and (ii)). This argument smacks of a hindsight analysis: the only motivation proposed for combining the references appears to be in order to achieve Applicant's invention.

The Final Office Action has not shown that there is some suggestion or motivation to combine the references, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Neither reference suggests such a combination. Further, the mere fact that the references are in the same field of art (and Applicant does not concede this point) is insufficient suggestion or motivation to combine. Additionally, the cited portions of Stiffler do not teach or suggest using "priorities of applications to free resources to run applications," as indicated on p. 5 of the Final Office Action.

Application No. 10/609,363

At least for these reasons, Applicant respectfully submits that independent claim 25 and all claims dependent therefrom are allowable over the cited portions of Mashayekhi and Stiffler. At least for similar reasons, Applicant respectfully submits that independent claim 36 and all claims dependent therefrom are also allowable over the cited portions of Mashayekhi and Stiffler.
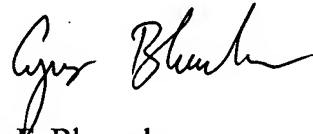
In view of the above amendments and remarks, the application is believed to be in condition for allowance and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is invited to telephone the undersigned.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA, 22313-1450, on May 21, 2007.

_____   _2007 May 21_
Attorney for Applicant   Date of Signature

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     Application No. 10/609,363